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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/725,282

12/01/2003

Courtney Flem Morgan

CL/V-32784A

1827

1095

7590

02/09/2005

NOVARTIS  
CORPORATE INTELLECTUAL PROPERTY  
ONE HEALTH PLAZA 104/3  
EAST HANOVER, NJ 07936-1080

EXAMINER

COLLINS, DARRYL J

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/725,282	Applicant(s) MORGAN ET AL.	
	Examiner Darryl J. Collins	Art Unit 2873	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 4 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06182004</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION*****Drawings***

Figure 3A should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Payor et al. Payor et al teaches a contact lens (Figure 10, element 80) having one or more optimized optical zones that accommodate the specific optical variations of the wearer's eye (Figure 10, elements 82 and 84) wherein one or more optical zones are placed within the contact lens in relation to the line of sight of the wearer (column 7, lines 41-47) as claimed in independent claim 1. Payor et al also teaches mechanical features such that the optical zone or zones are positionally maintained while being worn by the wearer (column 5, lines 61-65) as claimed in dependent claim 2 and the

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placement of the optical zones based upon the use in the eye of the user (column 7, lines 41-57) as claimed in dependent claim 5.

Claims 7, 9, 10 and 12 - 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Blum et al. Blum et al teaches a method of manufacturing a contact lens having one or more optical zones comprising the steps of obtaining information about the line of sight of the eye (column 2, lines 42-44) and determining the position of the optical zones (column 3, lines 16-30) as claimed in independent claims 7 and 13 and dependent claims 12 and 14, providing mechanical features to maintain the position of the optical zones with respect to the wearer and to optimize optical zone location (column 3, lines 38-42) as claimed in dependent claim 9 and obtaining information about the line of sight through corneal topography (column 3, lines 21-24) as claimed in dependent claim 10.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payor et al, as applied to independent claim 1 above, in view of Lieberman et al. Although Payor et al teaches all limitations as claimed in independent claim 1, Payor et al fails to teach the use of corneal topography as a technique in the design of the contact lens. Lieberman et al teaches the use of corneal topography as a well-known technique in the design process of a multiple zoned contact lens (column 2, lines 45-49) as claimed in dependent claim 3. Therefore, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to use the technique as taught by Lieberman et al to construct the contact lens as taught by Payor et al to provide a better fit for the contact wearer.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payor et al as applied to independent claim 1 above, in view of Gladys et al. Although Payor et al teaches all limitations as claimed in independent claim 1, Payor et al fails to teach the use of a multi-axis cutting system for creating the claimed contact lens. Gladys et al teaches the use of the well-known process of using a multi-axis lathe (column 7, lines 40-48) in the contact lens manufacturing art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well-known technique of contact lens manufacturing as taught by Gladys et al to achieve the multiple zones contact lens as taught by Payor et al to achieve a correctly shaped lens.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al, as applied to independent claim 7 above, in view of Gladys et al. Although Blum et al teaches all limitations as claimed in independent claim 7, including the use of a machining technique to produce the contact lens (column 3, lines 43-46), Blum et al fails to teach the use of a multi-axis cutting system for creating the claimed contact lens. Gladys et al teaches the use of the well-known process of using a multi-axis lathe (column 7, lines 40-48) in the contact lens manufacturing art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well-known technique of contact lens manufacturing as taught by Gladys et al in the manufacture of a multiple zones contact lens as taught by Blum et al to achieve a correctly shaped lens.

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*Allowable Subject Matter*

Claims 4 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

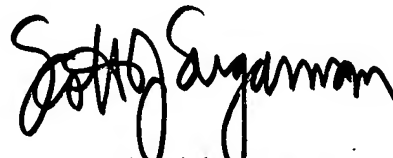
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darryl J. Collins whose telephone number is 571-272-2325. The examiner can normally be reached on 6:30 - 5:00 Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



djc



Scott J. Sugarman  
Primary Examiner